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811

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/533,381	03/22/00	FANTO	N 2801-14

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HM12/0118

EXAMINER

BARTS, S

ART UNIT	PAPER NUMBER
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1621

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DATE MAILED:

01/18/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

# Office Action Summary

Application No.  
**09/533,381**

Applicant(s)  
**Fanto et al**

Examiner  
**SAMUEL BARTS**

Group Art Unit  
**1621**



☒ Responsive to communication(s) filed on Oct 2, 2000

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

## Disposition of Claims

☒ Claim(s) 8-20 is/are pending in the application.

Of the above, claim(s) 12-20 is/are withdrawn from consideration.

☒ Claim(s) 10 is/are allowed.

☒ Claim(s) 8, 9, and 11 is/are rejected.

☐ Claim(s) \_\_\_\_\_ is/are objected to.

☐ Claims \_\_\_\_\_ are subject to restriction or election requirement.

## Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been  
☐ received.

☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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### **DETAILED ACTION**

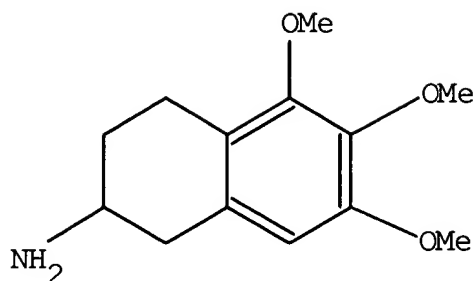
1. Newly submitted claims 12-20 directed to an invention drawn to methods for treating and preventing a variety of maladies is independent or distinct from the invention originally claimed for the following reasons: The original claims were drawn to compounds and composition. The two inventions are distinct because the claimed compounds and compositions could be used for a different methods of use such as the treatment of psychomimetics illnesses

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 12-20 withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

### ***Response to Arguments***

2. Applicant's arguments filed October 2, 2000 have been fully considered but they are not persuasive. Applicant has amended the claims to exclude some compounds. However, applicant has failed to exclude the compound of the prior art Chem. Abstract 110101. Applicant has argued that the particular compound pointed to by examiner does not have  $R=R_2=R_1=OCH_3$  substitution. The examiner does not agree. The compound disclosed by Chem. Abstract is reproduced below

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The registry number is 33446-12-7.

Because the record clearly indicates that this compound was disclosed in the prior art the rejection is being maintained.

***Allowable Subject Matter***

3. Claim 10 is allowed.

***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claim 8 and 11 are rejected under 35 U.S.C. 102(b) as being anticipated by Chem.

Abstracts 110101q. The registry number is 33446-12-7.

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Claim 8 is clearly anticipated because this reference discloses the claimed compound wherein  $R=R_1=R_2=O-CH_3$ . Claims 11, drawn to compositions, is also anticipated because the compound in the prior art is also a pharmaceutical and nothing of record suggest that different carriers are NEEDED for the particular recited diseases in the instant claims.

***Claim Rejections - 35 USC § 103***

6. Claims 8-9 is rejected less than 35 U.S.C. 102(b) as anticipated by or, in the alternative, less than 35 U.S.C. 103(a) as obvious over Chem. Abstracts 110101q.

The instant claimed invention is substantially disclosed. The prior art is silent as to the use of a salt for its administration as a pharmaceutical. However, the use of salts of active compounds in the pharmaceutical art is extremely well known. It is a main mode of modifying a compound to make it more suitable to deliver to a patient. Therefore, it would have been obvious to one having ordinary skill in the art at the time that applicants' invention was made to have modified the compound of the prior art to make a salt.

A skilled artisan would be motivated to perform such a change in order the make the compound in the most suitable form for administering the drug.

***Conclusion***

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

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A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner Samuel Barts whose telephone number is (703)308-4630. The Examiner's normal tour of duty is between 6:30-3:00, M-F. Any inquiry of a general nature or relating to the status of this application should be directed to the Group 1600 receptionist whose telephone number is (703) 308-1235. Communications may now be transmitted via FAX directly to group 1600. The official group 1200 FAX machine number is (703) 308-4556.

  
SAMUEL BARTS  
PRIMARY EXAMINER  
GROUP 1600

S.B.  
January 15, 2001  
Fax (703)308-4556